

## **REMARKS / ARGUMENTS**

This is meant to be a complete response to the Office Action mailed April 23, 2010. To begin with, Applicant would like to thank Examiner Masud for reviewing the instant application in view of the cited references. For at least the reasons set forth below, it is Applicant's belief that the cited reference does not disclose or render obvious the inventive subject matter recited in the pending claims. Reconsideration and withdrawal of the rejections contained in the Office Action is therefore respectfully requested.

In the response, the currently pending claims are provided for the convenience of the Examiner only and do not contain any amendments.

### **Claim Rejection(s) – 35 U.S.C. § 101**

In the Office Action, claims 1-24 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In particular, relying on the "machine-or-transformation" test, the Office Action states that independent claims 1, 9 and 17, include the limitation of "a host system" but that "the host systems do not appear to be anything more than a website." The Office Action directs Applicant's attention to paragraph [0023] for support, which recites one example of implementing the host system.

Even though the machine-or-transformation test is not the exclusive test for determining patent eligible subject matter, the currently pending claims satisfy the machine-or-transformation test because they are tied to a particular machine, e.g., the host system. See *Bilski v. Kappos*, 561 U.S. \_\_\_\_ (2010). As recited in

paragraph [0023], the “host system 12 can be any system, such as a computer system, which is capable of transmitting and receiving information from a large number of independent and/or non-affiliated systems, such as the health care provider systems 14 and the pharmacy systems 16.” A computer system capable of transmitting and receiving information from a large number of systems, even if the transmitting and receiving are accomplished over the internet, is a particular machine and therefore renders the methods set forth in claims 1-24 patent eligible subject matter in accordance with 35 U.S.C. § 101 and *Bilski*.

Also, Applicant submits that the host system imposes meaningful limits on the claims scope by reciting that the host system implements the claimed steps<sup>1</sup>. For example, with regard to claim 1, the steps of *receiving*, *generating*, *receiving*, and *transmitting* are all implemented “via the host system.” Similar limitations can be found in independent claims 9 and 17. Implementation of the claimed steps by the host system is more than just a nominal or tangential involvement between the host system and the claimed steps.

In view of the above, Applicant submits that claims 1-24 are specifically tied to a particular machine and are therefore directed to patent eligible subject matter. Reconsideration and withdrawal of the rejection of claims 1-24 under 35 U.S.C. § 101 is therefore respectfully requested.

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<sup>1</sup> See Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski V. Kappos*, Robert W. Bahr, Acting Associate Commissioner for Patent Examination Policy, July 27, 2010.

Claim Rejection(s) – 35 U.S.C. § 103(a)

In the Office Action, claims 1-5, 7-13, 16-21, and 23-24, were rejected under 35 U.S.C. § 103(a) as being unpatentable over Garcia (U.S. Patent No. 6,088,429), and further in view of Kobylevsky (U.S. Publ. No. 2005/0060200). In particular, the Office Action states that the Garcia reference discloses the features recited in independent claims 1, 9, and 17, except for explicitly disclosing the step of “receiving, via a host system communicating with the internet.” The Office Action then states that the secondary Kobylevsky reference discloses such feature and that it would have been obvious to modify Garcia’s system to include such features. While Applicant agrees with the Examiner that the Garcia reference does not disclose said step, Applicant submits that Garcia also does not disclose “generating a unique identification code...identifying the set of prescription information” or “transmitting the set of prescription information and the unique identification code to the computer system associated with the health care provider.” Therefore, even if Garcia were combinable with the Kobylevsky reference, the resultant combination does not arrive at the inventive features recited in the pending independent claims, and therefore claims dependent therefrom.

Garcia’s system attempts to solve the inherent problems associated with (1) verbal instructions from a pharmacist to a patient which are easily forgotten, and (2) written instructions from a pharmacist to a patient which are easily lost. (see col. 1, lines 10-15). In particular, Garcia’s system is meant to provide:

a more comprehensive system for communicating important information relating to side effects, usage and general information

for medications of every sort, independent of the specific manufacturer. There also remains a need for an interactive medication information system which provides immediate, on-demand answers to important questions of users at a level easily understood by the lay user and that is simple to use. (see col. 1, lines 30-38).

Garcia's system provides an automated telephony system that communicates with "the patient, or another individual acting on behalf of the patient," to provide information to the patient related to "(1) refill or renew prescription, (2) check on refill status, (3) get educational information about patient's (a) medications, (b) diagnosis information, (c) treatment plans, (d) patient's status." (see col. 2, lines 47-50 and col. 9, lines 24-29). Using a patient identifier, such as a social security number or a telephone number commonly known to family and friends, the patient can access Garcia's system to thereby obtain desired information and/or perform certain steps.

Garcia's system does not teach or suggest that the host system generates "a unique identification code...identifying the set of prescription information" received "from the computer system associated with the health care provider." In support of the proposition that Garcia discloses such features, the Office Action directs Applicant's attention to col. 7, lines 13-17, and to col. 13, lines 57-61. While Applicant agrees with the Examiner that Garcia mentions a "unique identifier" at col. 7, lines 13, Applicant respectfully submits that Garcia's unique identifier does not identify the set of prescription information received from the computer system associated with the health care provider. Instead, Garcia's discussions regarding a unique identifier or an "identification" at col. 13, line 58, refers to the identification used to authenticate the caller into Garcia's system to

thereby correlate the caller to the patient profile. Garcia describes this unique identifier as something “that only a patient or a family member would recognize as belonging to the patient (e.g., part of a social security number, birth date, or mother’s maiden name).”

Specifically, Garcia teaches:

The audio communication contains a unique patient identifier which is specifically associated with one of the patients in the database 214. This identifier may be used both to identify the patient to which the audio communication pertains and as a means of authentication to confirm that the caller is authorized to interact with the system 300. The system performs the authentication. (col. 3, lines24-31).

A unique identifier used to authenticate a patient/caller into Garcia’s system does not disclose a unique identification “identifying the set of prescription information” received from a computer system associated with the health care provider, as required by the instant claims.

Further, although Garcia does discuss using the unique identifier to authenticate a patient/caller, Garcia is silent, and therefore does not disclose or suggest “generating [the] unique identification, via the host system,” as also required by the instant claims. Instead, Garcia specifically discloses a unique identifier as something unique to the patient “that only a patient or a family member would recognize as belonging to the patient.” Garcia provides examples of patient data that can be used as an identifier as the patient’s social security number, date of birth, mother’s maiden name, or the patient’s telephone number. Garcia does not at all disclose or suggest that these identifiers are generated by Garcia’s system. Instead, these identifiers are innate features of the patient wherein Garcia’s system then uses these innate features as a form of

authentication and association of an incoming caller with the corresponding patient's profile. Therefore, Garcia does not disclose "generating a unique identification, via the host system," as required by the pending claims.

Additionally, Garcia does not disclose or suggest the step of "transmitting the set of prescription information and the unique identification code to the computer system associated with the health care provider," as recited in independent claims 1, 9 and 17. In support of the proposition that Garcia discloses this feature, the Office Action directs Applicant's attention to column 4, lines 7-11, and to column 9, lines 8-44.

At column 4, Garcia states that the prescriptions stored in the database can include a National Drug Code, which is a common method of identifying particular medications. While the databases accessed by Garcia's system might include the NDC, Garcia does not transmit this information, or any information to a computer system associated with the health care provider. Therefore, Garcia does not disclose transmitting the set of prescription information and the unique identification code to the computer system associated with the health care provider.

At column 9, Garcia generally discusses a patient phoning Garcia's telephony system and inputting their unique identifier to authenticate onto the system. Once Garcia's system verifies the patient, the patient can then select various options including refilling or renewing a prescription, check on a refill status or the like. If the patient selects the refill function, Garcia's system "posts the refill, renewal and status request to the pharmacy host system 224." More

particularly, Garcia specifically states that the system transmits a patient's prescription refill request directly to an external pharmacy. This does not disclose "transmitting the set of prescription information and the unique identification code to the computer system associated with the health care provider," as required by the pending claims.

Further, it would not have been obvious to modify the Garcia reference to include the step of transmitting because Garcia's system is not at all directed to a prescription verification system. The unique identifier disclosed by the Garcia reference is, for example, the patient's telephone number or mother's maiden name rather than a unique identification code "identifying the set of prescription information" received from "a computer system associated with the health care provider." Garcia's system is designed to communicate "important information [to the patient] relating to side effects, usage and general information for medications." Why would one skilled in the art be motivated to modify Garcia's system such that it transmitted the patient's mother's maiden name to a computer system associated with the health care provider? Such a modification would not further Garcia's stated purpose of informing patients of the side effects of their medication.

Next, the Office Action offers the Kobylevsky reference for the proposition that it discloses "receiving, via a host system communicating with the internet." While Applicant agrees with the Examiner that the Garcia reference does not disclose said feature, Applicant respectfully submits that the Kobylevsky reference does not disclose the features noted missing from the Garcia

reference. Therefore, even if the Garcia reference were combinable with the Kobylevsky reference, the resultant combination still would not arrive at the inventive subject matter recited in the instant claims.

The Kobylevsky reference is directed to a remote prescription refill system. As previously discussed, the Kobylevsky reference does appear to permit a doctor to phone in and “record new prescriptions and/or refill authorizations” at paragraph [0068]. However, the information flow is one-way in that it only permits information to flow into the pharmacy. Specifically, the communication flow is either patient-to-pharmacy or doctor-to-pharmacy. Thus, Kobylevsky does not teach or disclose “transmitting the set of prescription information and the unique identification code to the computer system associated with the health care provider.”

Further, Kobylevsky does not teach or suggest “generating a unique identification code, via the host system, identifying the set of prescription information” received from the computer system associated with the health care provider. Instead, Kobylevsky only teaches that the voice message received from the doctor is forwarded to the pharmacy. (See Fig. 12, step 170).

In view of the above, even if the Kobylevsky reference disclosed “receiving, via a host system communicating with the internet,” modifying Garcia’s system to include such feature still would not arrive at the inventive concepts recited in Applicant’s independent claims 1, 9 and 17, and therefore claims dependent therefrom.



In view of the above, Applicant respectfully submits that the combination of the Garcia reference and the Kobylevsky reference does not teach or even suggest each of the features recited in the Applicant's independent claims 1, 9 and 17, and therefore claims dependent therefrom. Reconsideration and withdrawal of the rejection of claims 1-5, 7-13, 16-21, and 23-24, under 35 U.S.C. §103(a) is therefore respectfully requested.

Claim Rejection(s) – 35 U.S.C. § 103(a)

In the Office Action, claims 6, 14, and 22 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Garcia and Kobylevsky, as applied to claims 1, 4, 9, 12, 17, and 20 above, and further in view of Boyer et al. (U.S. Pat. No. 6,202,923). In particular, the Office Action offers the Boyer reference for the proposition that it discloses the user being associated with an insurance company. The Office Action then suggests that it would have been obvious to modify the Garcia/Kobylevsky combination to include such features and that the resultant combination discloses the features recited in claims 6, 14, and 22. Applicant respectfully disagrees and submits that the prior art references, standing alone or in combination, do not disclose or otherwise render obvious the subject matter recited in independent claims 1, 9 and 17, as amended, and thus the claims which depend therefrom.

In particular, for at least the reasons set forth above, and not repeated here for the sake of brevity, the Garcia/Kobylevsky combination fails to teach every element contained in Applicant's independent claims 1, 9 and 17, and

therefore claims depending therefrom. Further, a careful review of Boyer reveals that it fails to correct the deficiencies noted in the Garcia/Kobylevsky combination.

Boyer et al. is directed to an automated pharmacy system. Essentially, Boyer teaches a method and system to be used in a pharmacy to reduce the chance of human errors when filling multiple prescriptions. More particularly, Boyer's automated pharmacy includes a data entry workstation for processing data relating to a prescription, a filling workstation for dispensing a drug type in a container, a checking workstation where a pharmacist checks and validates that the correct prescription has been dispensed, a counseling workstation for providing information to a customer, and a point-of-sale workstation for providing a prescription to a customer and receiving payment therefore. Essentially, Boyer facilitates automated dispensing of drugs and the only "verification" that Applicant can locate in Boyer (albeit a very important verification) is to make sure that the right pill gets in the right bottle for a given prescription. The prescriptions that Boyer fills are provided in either written form or call in form. (col. 6, lns. 5-13). However, Boyer does not disclose the steps of generating a unique identification code or transmitting the set of prescription information and the unique identification code to the computer system associated with the health care provider. Therefore, the teachings of the Garcia/Kobylevsky combination combined with that of Boyer still does not arrive at the inventive concepts set forth in claims 6, 14 and 22.

In view of the argument set forth above, Applicant respectfully submits that independent claims 6, 14, and 22 are not anticipated or rendered obvious over the aforementioned cited references, alone or in combination. Thus Applicant respectfully requests consideration and withdrawal of the rejection of claims 6, 14, and 22 under 35 U.S.C. §103(a).

### **CONCLUSION**

Applicant respectfully submits that this application is in condition for allowance for the reasons stated above. Therefore, it is requested that the Examiner reconsider each and every rejection as applicable to the claims now pending in the application and pass such claims to issue.

The foregoing is intended to be a complete response to the Office Action mailed April 23, 2010. In the event that any outstanding issues remain that would delay the allowance of this application, Applicant's attorney welcomes the opportunity to telephonically discuss such issues with the Examiner.

Respectfully submitted,



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